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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,528	04/22/2004	Alan Thomas Schachtely	136240	7324
7590 02/25/2009				
John S. Beulick Armstrong Teasdale LLP Suite 2600 One Metropolitan Square St. Louis, MO 63102			EXAMINER GAMIL TEJAL	
			ART UNIT 2121	PAPER NUMBER
			MAIL DATE 02/25/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/829,528

Applicant(s)

SCHACHTELY ET AL.

Examiner

TEJAL J. GAMI

Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-56 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12, drawn to a method of managing a machinery monitoring system, classified in class 700, subclass 103.
- II. Claims 13-18, drawn to a method of managing a modular software application, classified in class 709, subclass 224.
- III. Claims 19-22, drawn to a method of protecting, classified in class 700, subclass 174.
- IV. Claims 23-39, drawn to a network, classified in class 702, subclass 182.
- V. Claims 40-56, drawn to a computer program, classified in class 702, subclass 188.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, III, IV, and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. See MPEP § 806.05(d).

In the instant case, the subcombinations have separate utility such as a method of managing a machinery monitoring system does not require a method of managing a modular software application, as required by invention II; a method of managing a machinery monitoring system does not require a method of protecting, as required by

invention III; a method of managing a machinery monitoring system does not require a network, as required by invention IV; a method of managing a machinery monitoring system does not require a computer program, as required by invention V;

a method of managing a modular software application does not require a method of managing a machinery monitoring system, as required by invention I; a method of managing a modular software application does not require a method of protecting, as required by invention III; a method of managing a modular software application does not require a network, as required by invention IV; a method of managing a modular software application does not require a computer program, as required by invention V.

a method of protecting does not require a method of managing a machinery monitoring system, as required by invention I; a method of protecting does not require a method of managing a machinery monitoring system, as required by invention II; a method of protecting does not require a network, as required by invention IV; a method of protecting does not require a computer program, as required by invention V;

a network does not require a method of managing a machinery monitoring system, as required by invention I; a network does not require a method of managing a machinery monitoring system, as required by invention II; a network does not require a method of protecting, as required by invention III; a network does not require a computer program, as required by invention V; and

a computer program does not require a method of managing a machinery monitoring system, as required by invention I; a computer program does not require a method of managing a machinery monitoring system, as required by invention II; a

computer program does not require a method of protection, as required by invention III;
a computer program does not require a network, as required by invention IV.

As presently filed, and with respect to the explanation of this restriction requirement, claims 1-12 are subcombinations useable together in the same combination, wherein these claims are representative of different features disclosed with respect to the "a method of managing a machinery monitoring system." These claims 1-12 are notated as subcombination group I.

As presently filed, and with respect to the explanation of this restriction requirement, claims 13-18 are subcombinations useable together in the same combination, wherein these claims are representative of different features disclosed with respect to the "a method of managing a modular software application." These claims 13-18 are notated as subcombination group II.

As presently filed, and with respect to the explanation of this restriction requirement, claims 19-22 are subcombinations useable together in the same combination, wherein these claims are representative of different features disclosed with respect to the "a method of protecting." These claims 19-22 are notated as subcombination group III.

As presently filed, and with respect to the explanation of this restriction requirement, claims 23-39 are subcombinations useable together in the same combination, wherein these claims are representative of different features disclosed with respect to the "a network." These claims 23-39 are notated as subcombination

group IV.

As presently filed, and with respect to the explanation of this restriction requirement, claims 40-56 are subcombinations useable together in the same combination, wherein these claims are representative of different features disclosed with respect to the "a computer program." These claims 40-56 are notated as subcombination group V.

To summarize, the applicant should elect I, II, III, IV, or V.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Tejal J. Gami whose telephone number is (571) 270-1035. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert DeCady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Albert DeCady/
Supervisory Patent Examiner
Tech Center 2100

/TJG/

